

## REMARKS

The foregoing amendment is submitted in response to the Office Action dated April 7, 2004.

The examiner's comments have been carefully considered, and are addressed in turn in the following paragraphs.

### Priority Claim

Applicant claims priority of prior provisional application 60/435,131. The priority claim was set forth in the Application Data Sheet, as required under 37 C.F.R. 1.78(a)(5), which reads:

(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

(ii) This reference must be submitted during the pendency of the later-filed application. If the later-filed application is an application filed under 35 U.S.C. 111(a), this reference must also be submitted within the later of four months from the actual filing date of the later-filed application or sixteen months from the filing date of the prior-filed provisional application. If the later-filed application is a nonprovisional application which entered the national stage from an international application after compliance with 35 U.S.C. 371, this reference must also be submitted within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) in the later-filed international application or sixteen months from the filing date of the prior-filed provisional application. These time periods are not extendable. Except as provided in paragraph(a)(6) of this section, the failure to timely submit the reference is considered a waiver of any benefit under 35 U.S.C. 119(e) to such prior-filed provisional application. The time periods in this paragraph do not apply if the later-filed application is:

(A) An application filed under 35 U.S.C. 111(a) before November 29, 2000;  
or

(B) A nonprovisional application which entered the national stage after compliance with 35 U.S.C. 371 from an international application filed under 35 U.S.C. 363 before November 29, 2000.

***(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76),***

*or the specification must contain or be amended to contain such reference in the first sentence following the title.*

(iv) If the prior-filed provisional application was filed in a language other than English and an English-language translation of the prior-filed provisional application and a statement that the translation is accurate were not previously filed in the prior-filed provisional application or the later-filed nonprovisional application, applicant will be notified and given a period of time within which to file an English-language translation of the non-English-language prior-filed provisional application and a statement that the translation is accurate. In a pending nonprovisional application, failure to timely reply to such a notice will result in abandonment of the application.

37 C.F.R. 1.78(a)(5), emphasis added.

Applicant is unaware of any Rule or MPEP section that requires that the Declaration of Inventor include a priority claim. By the amendment submitted herewith, the specification has been amended to include the priority claim. However, should the examiner renew the requirement request for a new Declaration of Inventor containing a priority claim, such declaration will be provided by the Applicant.

**Response to Objection to Disclosure under 35 U.S.C. §112:**

The examiner has objected to the disclosure under 37 CFR §1.163 and 35 USC §112, first paragraph. The objection to the disclosure is followed by a highly detailed request for additional descriptive information regarding the new variety. The examiner cites 35 USC §162 to support the objection and request for additional descriptive information.

35 USC §162 reads:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

This statute acknowledges that an enabling written description cannot be provided for a plant, and so allows instead a reasonably complete description. Applicant asserts that for the purposes of a plant patent specification, a reasonably complete description identifies the novel, distinguishing, and non-variable characteristics of a new plant variety, and additionally points out commercially relevant features of the variety. This assertion is borne out in 37 CFR §1.163(a):

The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents. . .

A reasonably complete description does not include each and every quantifiable feature of the plant. While a highly detailed description may have merit for some purposes (breeding program records, botanical publications, researcher's notes, etc.), it is neither required by law nor appropriate in a plant patent application.

The grant of a plant patent is described in 35 USC §163:

In the case of a plant patent, the grant shall include the right to exclude others from asexually reproducing the plant, and from using, offering for sale, or selling the plant so reproduced, or any of its parts, throughout the United States, or from importing the plant so reproduced, or any parts thereof, into the United States.

The botanical description and illustrations included in a patent for a new plant variety, combined with the claimed plant itself (or its asexually produced progeny), define the invention in which exclusive rights are claimed.

No amount of description, or lack thereof, will affect the scope of the claim in a plant patent. The claim of a plant patent includes the specific plant, including any of its parts, shown and described in the specification. No more, no less. By excluding variable and commercially irrelevant description from the specification, the applicant does not, and can not broaden the scope of the plant patent claim defined by the statute.

In order to enforce a plant patent against an infringer, the patentee must prove that the alleged infringing plant is an asexual reproduction, that is, that it is the progeny of the patented plant. *Imazio Nurseries, Inc. v. Dania Greenhouses*, 69 F.3d 1560, citing *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1390, 193 USPQ 264, 293. A highly detailed and exacting patent specification may be appealing to a botanist, a patent examiner, or a patent applicant, but it is not more useful or valuable in enforcing the exclusive rights of the patent owner than a reasonably complete specification that points out the distinguishing characteristics of the variety.

Many of the characteristics for which the examiner has requested additional descriptive information are subject to substantial variability. Some of the variables which can affect the observable characteristics of fruit trees include: soil type; fertilizers and agricultural chemicals; weather; climate; watering; plant stress; cultural practices; and disease.

A quantitative recitation of variable characteristics fails as a reasonably complete description as required by the statute. Without taking into consideration the unique attributes of plants as patentable subject matter, one might conclude that if some description is good - reasonably complete - then more description must be better. In a utility patent application, this may be true. Devices, compounds and methods are described in terms of physical properties bound by physical laws. In order to enable the invention claimed in the utility application, it may be necessary to provide a quantitative recitation of the physical characteristics of the invention, in some cases with a high degree of precision.

In contrast, no such enabling description is required, or even possible, in a plant patent application. The botanical description in a plant patent application is intended to aid in identifying the claimed plant, not to enable the reader to make the invention. A botanical description which exceeds the reasonably complete standard by providing description of variable characteristics does

not aid in identifying the plant, but in fact introduces vague and ambiguous information. So, rather than serving to improve the quality of the disclosure in a plant patent application, the addition of unnecessary, vague or ambiguous information diminishes its value as an aid in identifying the claimed plant. Applicant asserts that a reasonably complete description of a plant is limited to those characteristics which are used by those skilled in the art to identify plants of the variety claimed.

In the interest of obtaining allowance of the present application, applicant has attempted to gather the information requested by the examiner despite applicant's belief that the information is not reasonably necessary for a complete botanical description. The additional information has been incorporated into the specification, and is reflected in the attached substitute specification. Each of the examiner's specific objections is addressed in the following paragraphs, which bear the same paragraph references as used by the examiner.

- A. As noted above, the specification has been amended to refer to U.S. Provisional Application Ser. No. 60/435,131, under which the present application claims priority.
- B. Scionwood from the original mutated branch of the presently claimed tree was grafted onto two established 'Bing' cherry trees. The specification has been amended to include this information.
- C. The specification has been amended to more clearly state that the claimed variety reproduces true to type over successive asexually propagated generations.
- D. The specification has been amended to remove reference to Van Well Nursery as the particular location where the claimed variety was asexually propagated.
- E. The flavor of the fruit of the claimed variety is sweeter than 'Bing.' The specification has been amended to clarify this point.
- F. The storage life of the fruit of the claimed variety is longer than that of 'Bing.' The

specification has been amended to clarify this point.

- G. The fruit shown in FIG. 2 is fruit of the claimed variety. The specification has been amended to clarify this point.
- H. The specification as filed incorrectly refers to the comparison variety shown in FIG. 5 as 'BC 13S-2009.' The specification has been amended to correctly name the comparison variety.
- I. The specification describes the characteristics of the claimed variety as observed on the original mutated branch of the parent 'Bing' cherry trees. The specification has been amended to clarify this point.
- J. The specification has been amended to indicate the date of the observed plant.
- K. Through AA. In these paragraphs, the Examiner has requested specific botanical information, including measurements and color chart references. Applicant has attempted to obtain all requested information, and has imported such information into the specification via the foregoing amendment. To the extent that requested information is not provided, Applicant was unable to obtain the information due to seasonal limitations, and respectfully requests that those requirements be waived. Specific omissions are discussed below:

1. Branch length is not provided. Because the tree is subject to regular pruning, recitation of branch length would be meaningless.

2. The examiner has asked for an explanation of the phrase to "8 ½ to 9 row" when referring to the size of the fruit of the claimed plant. "Row" sizing is common in the commercial cherry industry. A page printed from the Washington State Fruit Commission regarding cherry sizing is attached for the examiner's reference and information. No change to the specification is deemed necessary by the applicant regarding the reference to row sizing.

3. A photograph of the entire tree is not readily available, and is therefore not provided at this time.

### CONCLUSION

In light of the foregoing amendment and remarks, applicant asserts that this application is in condition for allowance, and such action is now respectfully requested. The examiner is invited to contact applicant's undersigned representative regarding any remaining issues that require attention.

Respectfully Submitted,

STRATTON BALLEW PLLC

A handwritten signature in black ink, appearing to read "Michelle Bos", is written over the printed name and partially over the address.

Michelle Bos, PTO Reg. No. 45,499  
213 S. 12<sup>th</sup> Avenue  
Yakima, WA 98902  
Telephone (509) 453-1319  
Facsimile (509) 453-4704



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## Packaging

Northwest Cherries are available in a wide variety of sizes. Cherry sizes are described in "rows," dating back to when the industry place-packed the top layer in the box. A tight fit of ten cherries across the narrow face of the lug became "10-row" cherries. But a 10-row California cherry is smaller than a 10-row shipped from Washington. California ships an 18 pound net lug, Washington ships a larger 20 pound lug.

## Packaging & Sizing

The year 2002 proved to be an interesting and changing time for cherry packaging. Our regional reps reported that retailers throughout the U.S. are moving more and more to bags and clamshells.

- o Bags: 2 lb. is standard
- o Clamshells: 2 lb., 4 lb. are standard, 1 lb. available
- o Bulk: 20 lb. box is standard



9 Row, 29.8 m  
 9-1/2 Row, 28.2 m  
 10 Row, 26.6 m  
 10-1/2 Row, 25.4 m

11 Row, 24.2 m  
 11-1/2 Row, 22.6 m

12 Row, 21.4 m

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